

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

JOHN R. BLAKE et al.	Group Art Unit:	3653
Serial No.: 10/797,839	Examiner:	Gerald W. McClain
Filed: March 10, 2004	Confirmation No.:	5664
Docket No.: 247171-000390USPT	Customer No.:	41,230
For:	COIN PROCESSING DEVICE HAVING A MOVEABLE COIN RECEPTACLE STATION	

REPLY BRIEF UNDER 37 C.F.R § 41.41

MAIL STOP APPEAL BRIEF – PATENTS (VIA EFS)

COMMISSIONER FOR PATENTS
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

On November 6, 2009, Appellants filed an Appeal Brief and the appropriate fee pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 41.37, 41.20(b)(2). An Examiner's Answer was subsequently issued on March 3, 2010. Appellants now submit the following Reply Brief pursuant to 37 C.F.R. § 41.41. In compliance with the mandate of 37 C.F.R. § 41.41(a)(1), this Reply Brief is being timely filed within two months from the date of mailing of the aforesaid Examiner's Answer.

To the extent necessary, please charge any shortage of fees due in connection with the filing of this paper, including extension of time fees, to Nixon Peabody, P.C. Deposit Account No. 50-4181, Order No. 247171-000390USPT, and please credit any additional fees or overcharges to the same deposit account.

I. STATUS OF CLAIMS

Claims 1-32 were originally presented in this application. Claims 33 and 34 were subsequently added. Claims 6, 17-24, 28, 29 and 32 have since been cancelled, without prejudice or disclaimer. Thus, claims 1-5, 7-16, 25-27, 30, 31, 33 and 34 remain pending. No claims have been allowed by the Examiner. Claims 1-5, 7-16, 25-27, 30, 31, 33 and 34 have each been rejected two or more times, and are therefore the subject of this appeal.

II. GROUND S OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 26 and 27 are unpatentable under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

2. Whether claims 26 and 27 are unpatentable under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as their invention.

3. Whether claims 1, 2 and 4 are unpatentable under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Appl. Publ. No. 2002/0162724 A1, to Hino et al. (hereinafter “Hino”), in view of U.S. Patent Appl. Publ. No. 2001/0008358 A1, to Brustle (hereinafter “Brustle”).

4. Whether claim 3 is unpatentable under 35 U.S.C. § 103(a) as being obvious over Hino and Brustle, in view of U.S. Patent No. 6,318,537 B1, to Jones et al. (hereinafter “Jones”).

5. Whether claims 5, 7-9, 27, 33 and 34 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Hino, in view of U.S. Patent No. 4,387,942, to Lense (hereinafter “Lense”).

6. Whether claim 25 is unpatentable under 35 U.S.C. § 103(a) as being obvious over Hino in view of Lense.

7. Whether claim 25 is unpatentable under 35 U.S.C. § 103(a) as being obvious over Hino in view of Muellner.

8. Whether claims 27 and 33 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Hino in view of Muellner.

9. Whether claims 14-16 and 26 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Hino in view of Lense, and further in view of U.S. Patent Appl. Publ. No. 2002/0011393 A1, to Siemens (hereinafter “Siemens”).

10. Whether claims 14-16 and 26 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Hino in view of Muellner, and further in view Siemens.

11. Whether claims 10, 12, 13 and 30 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Hino in view of Lense, and further in view of Jones.

12. Whether claim 30 is unpatentable under 35 U.S.C. § 103(a) as being obvious over Hino in view of Muellner, and further in view of Jones.

13. Whether claim 31 is unpatentable under 35 U.S.C. § 103(a) as being obvious over Hino in view of Lense, and further in view of Jones.

14. Whether claim 31 is unpatentable under 35 U.S.C. § 103(a) as being obvious over Hino in view of Muellner, and further in view of Jones.

III. ARGUMENTS

A. THE 35 U.S.C. 112, FIRST PARAGRAPH, REJECTIONS OF CLAIMS 26 AND 27 ARE FACTUALLY ERRONEOUS AND LEGALLY IMPROPER

1. Claim 26

Claim 26 is rejected as allegedly failing to comply with the written description requirement of 35 U.S.C. § 112, ¶1. The Examiner states that “it was not specified that the door [*sic*] was ‘only’ moved ‘subsequent to the opening of the door of the housing’”. Examiner’s Answer, § 9, at 3. Once again, the Examiner bases this rejection on the unfounded allegation that “[t]here may be other causes of the movement such as tipping the apparatus.” *Id.* The Examiner clarifies his position in the Response to Arguments section of the Examiner’s Answer by finding that:

the term “only” in the claim excludes other movements of the coin receptacle platform besides those “subsequent to the opening of the door of the housing”. **The specification does not implicitly nor explicitly exclude other sequence of events happening before the coin receptacle platform is moved from the first position.** The door is disclosed to be opened before said movement of the coin receptacle platform, but no other movement is excluded from the original claims and disclosure as filed. Therefore, the phrase including “only” is not adequately disclosed in Appellants’ written description.

Id., at 19, § 10 (emphasis added). The 112, ¶ 1, rejection of claim 26 is erroneous for at least three reasons: first, there is no evidence showing that a person of ordinary skill in the art would not recognize that Appellants invented what is claimed; second, the rejection is based on an erroneous construction of the claim; and third, the original disclosure reasonably conveys to those skilled in the art that the Appellants invented the claimed subject matter.

a. There is no evidence showing that a person of ordinary skill in the art would not recognize that Appellants invented what is claimed in claim 26.

“A description as filed **is presumed to be adequate**, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption.” MPEP 2163.04 (emphasis added). *See, e.g., In re Marzocchi*, 439 F.2d 220, 224 (CCPA 1971). The reviewing examiner therefore carries the initial burden of proving, by

sufficient evidence and facts, why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. *See* MPEP 2163.04, citing *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976). *See, also, In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (The reviewing examiner “bears the initial burden ... of presenting a prima facie case of unpatentability.”).

The Examiner’s conclusions do not prove by a preponderance of evidence that a person of ordinary skill in the art would not find that the disclosure shows Appellants invented a method for processing coins, which includes opening the housing door of the coin sorting machine prior to moving a coin receptacle platform contained therein, and moving the coin receptacle platform only after the door is opened. MPEP directives required that the Examiner set forth “express findings of fact” which support the lack of written description conclusion, including “reasons why a person skilled in the art ... would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.” MPEP 2163.04. Generalized allegations, such as “the specification does not implicitly or explicitly [support the claim],” are not sufficient. *See id.* In addition, the findings of fact that are set forth by the Examiner address limitations that are not recited in the claim, as discussed below, and therefore are insufficient to meet the Examiner’s burden of proof. Heretofore, the Examiner has not provided express findings of fact **and** reasons why a person skilled in the art would find that the subject disclosure does not provide 112, ¶1, support for claim 26.

For at least the foregoing reason, the 112, ¶1, rejection of claim 26 is erroneous, and should therefore be reversed.

b. The 112, ¶1, rejection of claim 26 is based on an erroneous construction of the claim.

In rejecting claim 26 under 112, ¶ 1, the Examiner focuses on limitations that are **not** in the claim. In particular, claim 26 is rejected on the premises that: (1) there may be other causes of moving the coin receptacle platform, such as tipping the apparatus, *see* Examiner’s Answer, § 9, at 3; (2) the claim does not clarify how the coin receptacle platform is moved, *see id.*, at 19, § 10; and, (3) the specification does not exclude other events from happening before the coin receptacle platform is moved, *see id.* Appellants respectfully submit that the 112, ¶1,

rejection of claim 26 cannot be proper as it is based on an erroneous construction of the claim - i.e., the rejection is not based on the invention as claimed.

The focus of the written description requirement is on the invention “as claimed,” and the descriptive support provided therefore by the specification. *See* MPEP 2163; *Regents of the Univ. of Calif. v. Eli Lilly*, 119 F.3d 1559, 1566 (Fed. Cir. 1997), *cert. denied*, 523 U.S. 1089 (1998). The alleged possibility that there may be other causes of movement, such as tipping the apparatus, as proffered by the Examiner, does not establish that Appellants’ disclosure does not support what is claimed. Contrary to the Examiner’s allegations, there is nothing in the disclosure or on the record that establishes Appellants’ coin receptacle platform would be moved by tipping the coin processing machine. More importantly, however, these allegations have no bearing on the sufficiency of Appellants’ disclosure under 112, ¶1, because claim 26 does not set forth any limitations directed toward tipping the apparatus. Likewise, the Examiner’s additional remark that claim 26 does not clarify how the coin receptacle platform is moved from the first position is similarly inapposite to the 112, ¶ 1, inquiry, as claim 26 is a method claim and need not recite the manner of completing each claimed act. Finally, the Examiner’s allegation that Appellants’ disclosure does not exclude other events from occurring before the coin receptacle platform is moved is likewise irrelevant because claim 26 does not set forth limitations that expressly exclude all other events from happening before the coin receptacle platform is moved from the first position.

For at least the foregoing reason, the 112, ¶1, rejection of claim 26 is erroneous, and should therefore be reversed.

c. Appellants’ specification, as filed, provides written description support for claim 26.

The standard for determining compliance with the written description requirement is whether an applicant’s description “allow[s] persons of ordinary skill in the art to recognize that he or she invented what is claimed.” MPEP 2163.02, citing *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989). The Federal Circuit, in an *en banc* decision, just confirmed that the test for sufficiency is whether the applicant’s disclosure “reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad*

Pharmaceuticals, Inc. v. Eli Lilly and Co., Case No. 2008-1248, Slip Op. at 23 (Fed. Cir. March 22, 2010)(*en banc*)(internal citations omitted). To show “possession”, and thus compliance with the written description requirement, does not demand claim language be repeated verbatim in the detailed description portion of the specification. *See* MPEP 2163.02. Rather, one complies with 112, ¶1, written description by such descriptive means as words and figures that fully set forth the claimed invention. *See Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, (Fed. Cir. 1997).

The subject specification conveys with reasonable clarity that, as of the filing date, Appellants were in possession of the invention presented in claim 26. In particular, the specification and drawings convey to those of ordinary skill in the art that Appellants invented a method for processing coins with a coin processing machine, including requiring an operator to (1) first open the door of the coin processing machine housing prior to moving a coin receptacle platform; and (2) moving the coin receptacle platform only after opening the door of the housing. For instance, paragraph [0038] of the specification explains that the door 321 of FIG. 4A prevents unauthorized access to the coin bags 309. If an operator needs to access the coin bags 309, the operator first opens the door 321 and then moves the coin receptacle station 304 from the operating position. *See id.* Similarly, the exemplary embodiment of FIGS. 5a-c includes a housing door 413. Paragraph [0042] of the specification states that the rotatable bag station 404 permits an operator to access each of the coin bags 406 from the front of the coin processing device 400 after opening the door 413. Likewise, the coin processing device 500 of FIG. 6 (recreated below) also includes a security door 513 which, when closed, prevents access to or movement of the coin receptacles. Appellants’ specification explains that, in operation, an operator of the coin processing device 500 of FIG. 6 must first open either the front door 520 or rear door 522 of the housing 503 to access the coin receptacles. *See id.*, ¶ [0051]. Even the originally presented claims disclose “a door moveable between an open position and a closed position, the door permitting a moveable platform to move from the first position to the second position when the door is in the open position.” Claim 14. *See, e.g.*, MPEP 2163 (Compliance with 112, ¶1, may be by way of the original claims.). These various disclosures clearly evidence that the specification conveys, with reasonably clarity, that Appellants invented the subject matter of claim 26 as of the filing date sought.

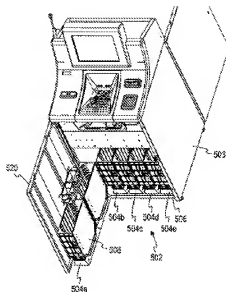


FIG. 6

As noted recently by the *en banc* Court of Appeals of the Federal Circuit, “we have recognized that determining whether a patent complies with the written description requirement will necessarily vary depending on the context” and that “[s]pecifically, the level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology. *Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*, Case No. 2008-1248, Slip Op. at 27 (Fed. Cir. March 22, 2010) (*en banc*)(internal citations omitted)(*citing Capon v. Eshhar*, 418 F.3d 1349, 1357-58 (Fed. Cir. 2005)). The relevant technology in the instant case, in view of the simplicity of the claims and predictability of the technology, is respectfully submitted by Appellants to reasonably convey to a person having ordinary skill in the art that the applicant had possession of the subject matter presently claimed. *See, e.g., Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). The Examiner’s “claim construction,” inappropriately introduces unnatural events outside of normal, routine operation, and appears not to be aimed at ascertaining whether the Appellant’s specification conveys with **reasonable clarity** that, as of the filing date, Appellants were in possession of the invention presented in claim 26.

In addition to the foregoing, Appellants note that the Examiner explicitly acknowledges that “[t]he door is disclosed to be opened before said movement of the coin receptacle platform,” *see* Examiner’s Answer, § 10, at 19, which clearly “demonstrates

possession” of the invention in claim 26, *see* Final Office Action, mailed Aug. 18, 2009 (hereinafter “Final Office Action”), at 17. The point of disagreement is the Examiner’s belief that “no other movement is excluded from the original claims and disclosure as filed.” Examiner’s Answer, § 10, at 19. However, as discussed above, claim 26 does not require exclusion of all other events before the coin receptacle platform is moved from the first position; as such, Appellants’ specification need not support this unclaimed limitation to comply with 112, ¶ 1. As such, there is in fact no disagreement that the invention “as claimed” in claim 26 is fully supported by the subject disclosure.

Claim 26 is submitted to be in full compliance with 35 U.S.C. § 112, ¶ 1, for at least these additional reasons. Reversal of this rejection and thus allowance of this claim is therefore respectfully requested.

2. Claim 27

Claim 27 is also rejected for purportedly failing to comply with the written description requirement of § 112, ¶1. The Examiner alleges that the original disclosure does not specify that Appellants’ claimed platform is “only” moved from the first operable position to said second inoperable position, and back. *See* Examiner’s Answer, § 9, at 4. This observation is premised on the belief that “[t]here may be other causes of the movement such as finite movement between the first and second [] positions.” *Id.* The Examiner clarifies his position in the Response to Arguments section of the Examiner’s Answer, asserting that:

[t]here are infinite intermediate positions between the first and second positions. Appellants’ disclosure does not exclude the possibility of the moveable platform and plurality of tracks from moving (1) between the first position and an intermediate position (point), (2) between the [above assumed] second position and an intermediate position, and/or (3) between two intermediate positions (points). Therefore, the above phrase comprising “only” is not adequately disclosed in Appellants’ written description since cases (1) through (3) are not implicitly nor explicitly excluded.

Id., § 10, at 20 (emphasis added). The 112, ¶ 1, rejection of claim 27 is erroneous for at least three reasons: first, there is no evidence showing that a person of ordinary skill in the art would not recognize that Appellants invented what is claimed; second, the rejection is based on an erroneous construction of the claim; and third, the original disclosure reasonably conveys to those skilled in the art that the Appellants invented the claimed subject matter.

- a. There is no evidence showing that a person of ordinary skill in the art would not recognize that Appellants invented what is claimed in claim 27.*

The Examiner's conclusions do not prove by a preponderance of evidence that a person of ordinary skill in the art would find that the disclosure does not show that Appellants invented the subject matter of claim 27. That is, the record is absent sufficient findings of fact and reasons why a person skilled in the art would conclude that the subject disclosure does not support a coin processing device that includes a plurality of individually moveable platforms, each of which is connected to a respective track and is physically constrained to slide only along that track when moving between the first, operable position and the second, inoperable position. Generalized allegations, such as "the specification as filed provides no support (implicitly or explicitly) for [claim 27]," Examiner's Answer, § 10, at 21, are not sufficient. *See* MPEP 2163.04. Once again, Appellants' specification "is presumed to be adequate" absent sufficient evidence to the contrary. *See* MPEP 2163.04. The findings of fact that are set forth by the Examiner address limitations that are not recited in the claim, as discussed below, and therefore are insufficient to meet the Examiner's burden of proof. *See* MPEP 2163.04. Heretofore, the Examiner has not provided any evidence supporting the conclusion that the invention "as claimed" is not adequately described under the tenets of 112, ¶ 1.

For at least the foregoing reason, the 112, ¶1, rejection of claim 27 is erroneous, and should therefore be reversed.

- b. The 112, ¶1, rejection of claim 27 is based on an erroneous construction of the claim.*

In rejecting claim 27 under 112, ¶ 1, the Examiner focuses on limitations that are not in the claim. In particular, claim 27 is rejected on the premises that there is no support in Appellants' specification for a plurality of individually moveable platforms that only move from the first operable position to the second inoperable position, and back. *See* Examiner's Answer, § 10, at 20. Appellants respectfully submit that the 112, ¶1, rejection of claim 26 cannot be

proper because it is based on an erroneous construction of the claim, and therefore is not based on the invention as claimed.

The focus of the 112, ¶ 1, written description requirement is on the invention “as claimed,” and the descriptive support provided therefore by the specification. *See* MPEP 2163; *Regents of the Univ. of Calif.*, 119 F.3d at 1566. The mere prospect that there may be other causes of movement, such as finite movement between the first and second positions, as proposed by the Examiner, does not establish that Appellants’ disclosure does not support what is claimed in claim 27. In fact, these allegations have no bearing on the sufficiency of Appellants’ disclosure under 112, ¶1, because claim 27 does not limit the range of motion of the moveable platforms to the first and second positions, but rather limits the path of motion, requiring that each platform “be[] physically constrained to slide only ... along a corresponding one of said plurality of tracks.” As such, what is relevant in the case at bar to the section 112, ¶1, inquiry is that any person of ordinary skill in the art, referencing the subject specification (e.g., paragraphs [0048]-[0052] in conjunction with FIGS. 6-8) would recognize that each of the claimed “individually moveable platforms” may be connected to and physically constrained so as to slide only along a corresponding track from the first position to the second position (and vice versa), as required by claim 27. Heretofore, there is no evidence on the record showing to the contrary.

For at least the foregoing reason, the 112, ¶1, rejection of claim 27 is erroneous, and should therefore be reversed.

c. Appellants’ specification, as filed, provides an adequate written description for claim 27.

The subject specification conveys with reasonable clarity that, as of the filing date, Appellants were in possession of the invention presented in claim 27. In particular, the specification and drawings clearly convey that Appellants invented a coin processing device that includes a plurality of individually moveable platforms, each of which is connected to a respective track and is “physically constrained to slide only from said first operable position to said second inoperable position [and vice versa] along a corresponding one of said plurality of tracks.” By way of example, FIG. 6 (recreated above) illustrates a coin processing device with a number of moveable platforms, each of which is connected to a respective track and is physically

constrained to slide only along the track. *See* MPEP 2163(II)(A)(3)(a) (“Possession may [] be shown by a clear depiction of the invention in detailed drawings ... which permit a person skilled in the art to clearly recognize that applicant had possession of the claimed invention.”) *See, also, Mahurkar*, 935 F.2d at 1565, (“drawings alone may provide a ‘written description’ of an invention as required by Sec. 112”). In particular, FIGS. 6 and 7 clearly show individually movable platforms 504a-e, where platform 504a, for example, is connected to a respective track, and is physically constrained to that track when sliding between a retracted, operable position and an extracted, inoperable position. FIG. 6 also shows each of the movable platforms 504b-e connected to a respective one of the tracks, and physically constrained to that respective track when sliding to the operable position, whereat the platforms are situated inside the housing 503. Accordingly, a person of ordinary skill in the art can clearly see that the moveable platforms 504a-e are “physically constrained to slide ... along a corresponding one of said plurality of tracks” when transitioning back and forth between the first and second positions. These various disclosures clearly evidence that the specification conveys, with reasonably clarity, that Appellants were in possession of the invention recited in claim 27 as of the filing date sought.

In the Response to Arguments section of the Answer, the Examiner correctly notes that the disclosure as a whole must be analyzed in determining whether Appellants have complied with 112, ¶1. *See id.*, at 21, ¶ 2. However, the Examiner thereafter improperly suggests that Appellants previously argued that 112, ¶ 1, support for claim 27 is found in what “the drawings do not show”. *See id.*, (Stating that “the test is not merely ‘what do the drawings not show?’”). At no point in the Appeal Brief, or otherwise, do Appellants argue that claim 27 is supported by subject matter **not** illustrated in the drawings. In direct contrast, Appellants have argued on numerous occasions that the Figures (in addition to the Detailed Description) provide explicit support for both claims 26 and 27. *See supra*, § III.A.1.C, at 7-10; Appeal Brief, §§ VII.B.1.b and 2.b; Amendment under 37 C.F.R. § 1.111, entered on May 22, 2009, § II.A.1, at 7-10. As such, Appellants respectfully submit that the Board should disregard the Examiner’s remarks directed to “what do the drawings not show?” on page 21 of the Answer.

Likewise, the fact that the disputed claim terms were added four years after the filing date of the application, and/or were allegedly added to overcome a prior-art based rejection, *see* Examiner’s Answer, § 10, at 21, ¶ 2, has no bearing on whether there is sufficient 112, ¶ 1, written description for such claim terms. It is surprising that the Examiner would even

argue this fact considering it took almost three years from filing for the first office action on the merits in this application to issue. Regardless, there is no statutory or judicial precedent which allows the Examiner to consider when or why a limitation was added to a claim in considering compliance with 35 U.S.C § 112, ¶1. As such, Appellants respectfully submit that the Board should disregard the Examiner's remarks directed to when or why the disputed claim terms were added to the claims.

For at least these additional reasons, claim 26 is submitted to be in full compliance with 35 U.S.C. § 112, ¶ 1. Reversal of this rejection and thus allowance of this claim is therefore respectfully requested.

B. THE 35 U.S.C 112, SECOND PARAGRAPH, REJECTIONS OF CLAIMS 26 AND 27 ARE FACTUALLY ERRONEOUS AND LEGALLY IMPROPER

Claims 26 and 27 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. With respect to claim 26, the 112, ¶ 2, rejection is premised on the Examiner's allegation that "it is unclear if there are ... other mechanisms for opening the door". Examiner's Answer, § 9, at 4. Likewise, as to claim 27, the Examiner alleges that "it is unclear if there are other movements of the platforms along the tracks." *Id.* The Examiner clarifies his position in the Response to Arguments section of the Examiner's Answer by finding that:

it is unclear how Appellants' claimed moveable platforms move from (1) only the first position in Claim 26 and (2) only between the first and second positions in Claim 27 since one of ordinary skill would recognize that there are infinite points between two discrete points (points not next to each other) on a line to which the platforms may pass through.

Id., at 22. The § 112, ¶2, rejections of claims 26 and 27 are both based on erroneous claim constructions, and are both violative of the MPEP and related judicial case law.

The objective test for definiteness under 112, ¶ 2, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986). *See, also*, MPEP 2173.02 (The essential inquiry pertaining to the definiteness requirement "is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity

and particularity.”) In general, the invention set forth in the claims “must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention.” *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). Moreover, the focus during examination of claims for compliance with the 112, ¶ 2, requirement for definiteness “is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available.” MPEP 2173.02.

Claim 26 recites two acts: (1) opening the door of the housing prior to moving any of the coin receptacle platforms, and (2) moving a coin receptacle platform only after opening the door of the housing. Federal case law and the MPEP asks whether claim 26 sets out and circumscribe this subject matter with “a reasonable degree of clarity and particularity.” *See Metabolite Labs, Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366-67 (Fed. Cir. 2004). FIG. 6 clearly exemplifies a coin processing machine 500 with two housing doors 520, 522, at least one of which that must be opened before the platform 504a can be extracted from the housing 503. As such, an operator of the coin processing machine 500 may be required to open one of the doors 520, 522 of the housing 503 prior to moving one of the platforms 504a-e, and may be restricted from moving a coin receptacle platform 504a-e until after one of the doors 520, 522 is in fact opened. If persons of ordinary skill in the art would understand such limitations as set forth in claim 26 when read in light of the specification (which Appellants submit they would), then 112, ¶ 2, is satisfied.

Whether or not there are “other mechanisms for opening the door,” as the Examiner posits, does not negate the clarity and particularity of the invention as claimed. The same can be said for the Examiner’s proposition that it is unclear “how Appellants’ claimed moveable platforms move from [] only the first position”. *See* MPEP 2173.02 (“[I]f the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph”). In regard to the former, even if there are other mechanisms for opening the door, as proposed by the Examiner, that does not render the content of claim 26 ubiquitous or ambiguous. In regard to the latter, claim 26 does not explicitly limit movement of the platform “only [from] the first position”; as such, there is no concern under 112, ¶ 1, standards whether such a limitation is clear and precise. As such, claim 26 satisfies the 112, ¶2, definiteness requirement.

Turning then to claim 27, the coin processing device presented therein includes a plurality of individually moveable platforms and a plurality of tracks. Each moveable platform is connected to a respective one of the tracks and is physically constrained to slide only along a corresponding one of the tracks. Federal case law and the MPEP asks whether claim 27 sets out and circumscribe this subject matter with a reasonable degree of clarity and particularity. FIG. 6 clearly exemplifies a coin processing machine 500 with a plurality of movable coin-receptacle platforms 504a-e, each of which is connected to and physically constrained to slide only along a respective track. Respectfully, there are no ambiguities or vagaries in the above-listed elements and corresponding limitations.

The Examiner has failed to discharge the burden to demonstrate that one of ordinary skill in the art, having read claim 27 in light of the specification, would fail to appreciate the subject matter set forth in the claim with a reasonable degree of clarity. *See, e.g., Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379 (Fed. Cir. 2000). Heretofore, the Examiner has not shown otherwise; as such, the rejection should be reversed. Whether or not there are “other movements of the platforms along the tracks,” as the Examiner posits, does not negate the clarity and particularity of the invention as claimed. The same can be said for the Examiner’s proposition that it is unclear “how Appellants’ claimed moveable platforms move from [] only between the first and second positions”. In regard to the former, even if there are other movements of the platforms along the tracks, as proposed by the Examiner, that does not render the content of claim 27 ubiquitous or ambiguous. In regard to the latter, the claim does not limit movement of the platform to only between the first and second positions; as such, there is no concern under 112, ¶ 1, standards whether such a limitation is clear and precise. As such, claim 27 satisfies the 112, ¶2, definiteness requirement.

For at least these additional reasons, claims 26 and 27 are submitted to be in full compliance with 35 U.S.C. § 112, ¶ 2. Reversal of these rejections and thus allowance of these claims is therefore respectfully requested.

C. ALL PENDING § 103(A) REJECTIONS ARE FACTUALLY ERRONEOUS AND LEGALLY IMPROPER

1. Claims 1-2 and 4

Claims 1, 2 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Brustle. The Examiner submits that Hino teaches every element and limitation of independent claim 1 except a dampening mechanism configured to exert a damping force on the coin receptacle station during movement of the coin receptacle from the first position to the second position and back. *See* Examiner's Answer, § 9, at 5. In light of this deficiency, the Examiner applies Brustle, alleging that Brustle teaches a dampening mechanism with first and second ends "for the purpose of disposing the dampening mechanism and the coin receptacle station into the housing (paragraph [0003])." *Id.* It would thus have been obvious, posits the Examiner, to modify Hino to include Brustle's dampening mechanism. *See id.* The pending § 103(a) rejection of independent claim 1 is improper for at least three reasons: first, the Brustle reference is non-analogous art; second, the Examiner has not provided a proper "apparent reason" to modify Hino in light of Brustle; and third, the proposed combination is improper as it would require a substantial redesign and reconstruction of the Hino reference.

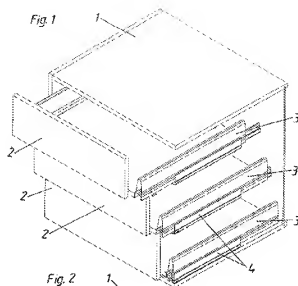
a. The Brustle reference is non-analogous art that may not be relied upon in rejecting the pending claims under § 103(a).

To rely on a reference under 35 U.S.C. 103, it must be analogous art. MPEP 2141.01(a). The doctrine of analogous art was created in recognition of the fact that it is unrealistic to expect an applicant to be aware of every teaching in every art. *See Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567, 1572 (Fed.Cir.1984). Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference is reasonably pertinent to the particular problem with which the inventor is involved. *See Comaper Corp. v. Antec, Inc.*, 2009-1248, Slip. Op. at 12 (Fed. Cir. Mar. 1 2010) (*precedential*); *In re Clay*, 966 F.2d 656, 658-59 (Fed. Cir. 1992). Patent Office classification of references and the cross-references in the official search notes of the class definitions are both evidence of "nonanalogy" and "analogy". *See* MPEP 2141.01(a). A reference in a field different from that of an applicant's

endeavor may sometimes be considered pertinent “if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his or her invention as a whole.” *Id.*, citing *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1397 (2007).

The Examiner contends that claim 1 can be broken down into a combination of three features: (1) a coin sorter, (2) a receptacle, and (3) movement (drawer) structures. *See* Examiner’s Answer, § 10, at 22. Based on this relegation of the various elements of claim 1, the Examiner contends that all of the rejections use secondary references that are either in the same field of the Appellants’ endeavor or are reasonably pertinent to the same problem with which the Appellants are involved. *See id.*, at 23. To that end, the Examiner concludes that a coin structure does not have to be disclosed in a secondary reference “if that reference’s disclosure is being used for a (3) movement structure of the combination (1-3) above in a 103(a) rejection since the (b) particular problem is in the, say, drawer art.” *See id.* The Brustle reference is non-analogous art, and therefore cannot be relied upon in rejecting the subject claims under § 103(a).

Brustle is in a different art from that of Appellants’ endeavor, and is therefore not analogous art. For instance, Appellants’ invention relates generally to coin processing devices, and more particularly to coin redemption machines with coin receptacles. *See* Specification, ¶ [0001]; Abstract. In contrast, Brustle’s invention relates to pull-out guidance assemblies for furniture drawers. *See* Brustle, ¶ [0001]; Abstract. In addition, Appellants’ invention is classified in class 194 (check-actuated control mechanisms), subclass 350 (with specific housing structure), whereas Brustle’s invention is classified in class 312 (cabinet structures), subclasses 319.1 and 334.7 (with biasing means between vertical sidewalls of drawer and cabinet). Likewise, Appellants’ and Brustle’s inventions were categorized under different international classifications (G07F 1/04 and A47B 88/04, respectively). The different U.S. and international classifications designated by the USPTO for Brustle and the subject application demonstrates that Brustle is non-analogous art. *See* MPEP 2141.01(a). Respectfully, such non-analogous art may not be relied upon in attempting to substantiate a 103(a) rejection of Appellants’ claims.



In addition to **not** being in the same field of endeavor, *Brustle* is not “reasonably pertinent” because the matter with which it deals, logically, would not have reasonably commended itself to an inventor’s attention in considering the present invention as a whole. A reference is considered to be “reasonably pertinent” if a person of ordinary skill would have consulted that reference and applied its teachings in seeking a solution to the problem that the inventor was attempting to solve. See *In re Bigio*, 381 F.3d 1320 (Fed. Cir. 2004); *In re GPAC Inc.*, 57 F.3d 1573, 1577 (Fed. Cir. 1995); *Heidelberger Druckmaschinen v. Hantscho Commercial*, 21 F.3d 1068, 1071 (Fed.Cir.1994). Contrary to the Examiner’s oversimplification of claim 1, the coin processing device presented therein includes a housing, a coin receptacle station, and a coin sorter with an input hopper, rotatable disk, and a stationary head. The coin receptacle station holds a plurality of coin receptacles, each of which holds coins of a single denomination. Claim 1 also incorporates a dampening mechanism that exerts a damping force on the coin receptacle station during movement between a first position, whereat the coin receptacle station is disposed entirely within the housing, and a second position, whereat the coin receptacle station extends out of the housing.

In attempting to design a platform and damper assembly that can simplify and alleviate the burden associated with supporting and moving voluminous coins of unwieldy bulk and weight (e.g., hundreds of pounds of coins that can be transported by a single operator), such as that presented in claim 1, a person of ordinary skill in the art would not reasonably look to the design of an ordinary furniture drawer, such as that presented by *Brustle*. See MPEP 2141.01(a);

In re Ellis, 476 F.2d 1370, 1372 (CCPA 1973) (Structural dissimilarities and lack of functional overlap support a conclusion that the cited reference is not analogous art.) For example, Brustle's stated objective of "improving a pull-out guidance assembly" for furniture drawers such that the "damper can be disposed in its entirety in the drawer," Brustle, ¶ [0003], does not address any of the problems addressed by Appellants' invention - e.g., ease of supporting and moving bulk coins.

The additional remarks set forth in the Response to Arguments section of the Examiner's Answer do not present any factual foundation or substantive evidence to support the contention that Brustle is reasonably pertinent to the particular problem with which the Appellants are involved. Rather, the determination of analogousness is based on the Examiner's conclusion that Brustle must be analogous because it presents "moving parts" and Appellants' invention includes "moving parts". See Examiner's Answer, § 10, at 23 ("[The] reference's disclosure is being used for a (3) movement structure ... since the (b) particular problem is in the, say, drawer art." Emphasis added.) Contrary to the Examiner's assertion, the mere fact that both Brustle and Appellants employ "moving parts" does not by itself establish that Brustle is analogous art. See *Estate of Stoller v. Ford Motor Co.*, 784 F.Supp. 506 (N.D.Ill. 1992) (Rotatable automobile sun visor not *per se* analogous to rotatable automobile head rest.). To conclude otherwise would defeat the sole premise of the doctrine of analogous art - i.e., any mechanical device with a moving part would be deemed analogous to Appellants' invention. The fact that Brustle's invention and Appellants' invention both have moving parts does not substantiate that a person of ordinary skill would have reasonably consulted Brustle in seeking a solution to the problem that Appellants were attempting to solve.

For at least the foregoing reasons, Appellants submit that the pending § 103(a) rejection of claims 1, 2 and 4 is erroneous, and therefore respectfully request this Honorable Board to reverse the Examiner at least upon these grounds.

b. The record is absent any “apparent reason” why persons of ordinary skill in the art would be compelled to combine Hino and Brustle to achieve Appellants’ invention.

The law of obviousness requires the reviewing examiner to clearly articulate “an apparent reason” why a person skilled in the art would be compelled to combine the elements taught in the applied references to achieve the invention “claimed by the patent at issue”. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. at 1741 (Such reasoning must “be made explicit.”). “Most if not all inventions arise from a combination of old elements.” *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). *See, also, In re Rouffet*, 149 F.3d 1350, 1357 (Fed.Cir. 1998). However, piecemeal identification in the prior art of each individual part claimed “is insufficient to defeat patentability of the whole claimed invention” unless there is an actual reason or motivation to combine those elements. *See In re Kotzab*, 217 F.3d at 1369. *See, also, In re Dance*, 160 F.3d 1339, 1343 (Fed.Cir. 1998).

As noted in Appellants’ Appeal Brief, § VII.D.1.b, the only ostensible motivation provided by the Examiner to combine Hino with Brustle is for the purpose of disposing the dampening mechanism and the coin receptacle station into the housing. *See Examiner’s Answer*, § 9, at 5-6; Final Office Action, at 4, ¶ 1. In actuality, this purported motivation to combine Hino with Brustle is merely a pretense to combine the elements from Hino with those of Brustle. That is, one would be motivated to combine Hino (Coin Sorter) and Brustle (Drawer Guidance Assembly), alleges the Examiner, in order to achieve a combination of Hino and Brustle (a coin sorter with a drawer guidance assembly). The Examiner’s failure to articulate an actual reason why a person of ordinary skill in the art would be compelled to combine the cited prior art to achieve the invention “in the fashion claimed” is grounds alone to render the entire § 103(a) rejection improper.

It was not until the Answer that the Examiner alleges, for the first time, that “combining the prior art dampening mechanism element according to known methods to the apparatus of Hino can yield predictable results, namely exert a dampening force between two relatively moving structures.” Examiner’s Answer, § 10, at 23. However, according to MPEP 2143(A), to properly reject a claim based on this rationale, an examiner “**must**” articulate:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

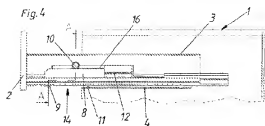
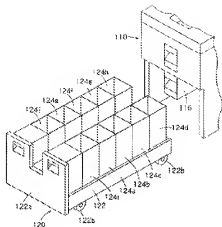
(4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

(Emphasis added.) The record does not reflect the findings required in items (2) and (3) above; consequently, the record is still missing the fully articulated apparent reason required by the Supreme Court in *KSR*. A *prima facie* case of obviousness is thus still lacking.

For at least the foregoing reasons, Appellants submit that the pending 103(a) rejection of claims 1, 2 and 4 is erroneous, and therefore respectfully request this Honorable Board to reverse the Examiner at least upon these grounds.

c. The Examiner's proposed combination of Hino and Brustle is improper because it requires a substantial reconstruction and redesign of Hino.

In addition to Brustle being non-analogous art and the lack of a proper motivation or reason to combine Hino and Brustle, any such combination is improper as it would require a reconstruction and redesign of the elements shown in the Hino reference, as well as a change in the basic principle under which Hino's storage unit 120 was designed to operate. An examiner's proposed modification of a cited reference is not sufficient to render a claim *prima facie* obvious "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified". See MPEP 2143.01(VI) ; *Ex parte Lovett*, 2007-1451 (BPAI June 13, 2007); *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959). The court in *Ratti* emphasized that a proposed modification which "change[s] the basic principle under which the [primary reference's] construction was designed to operate" is grounds for overturning a finding of obviousness. 270 F.2d at 813, (emphasis added). See, also, *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992).



Hino's storage unit 120 is specifically designed as a separate component from the housing of the coin processing unit 110 such that the storage unit 120 can be removed from the storage unit housing. *See*, Hino FIG. 4 (recreated above). As seen in FIG. 4, the storage unit 120 is not tethered or in any way mechanically coupled to the housing. *See, e.g.*, Hino, ¶ [0136] (“[T]he storage unit 120 and the return box 116 are independent of each other and can be individually drawn out.”). However, if one were to integrate Brustle's drawer guidance assembly, seen in reference FIG. 4 (recreated above), including attaching Brustle's housing 7 to Hino's processing device housing, and fastening sliding carrier 8, tension spring 12, and rotation damper 20 to Hino's storage unit 120, would require Hino's storage unit 120 be continuously attached and fixed to the coin processing unit 110. In so doing, an operator of Hino's coin processing device 110 would be constrained from moving the storage unit 120 away from the device 110.

The Examiner responds to these assertions in the Response to Arguments section of the Answer by opining, *in toto*, that “one of ordinary skill in the primary art would be able to incorporate the (secondary reference) dampening mechanism into the primary reference device.” *Id.*, at 23. Why would a person of ordinary skill in the art incorporate Brustle into Hino? As noted above, the Examiner has not properly articulated a cogent reason why a person of ordinary skill in the art incorporate Brustle into Hino. How would a person of ordinary skill in the art be able to incorporate Brustle’s dampening mechanism into Hino’s coin sorter? No such explanation or reasoning is provided beyond the conclusory statement that they “would” be able to do so. Does this averment, if true, in any way negate the fact that such a modification would require a substantial redesign of Hino (as well as Brustle, which cannot merely be “dropped into”

Hino), and would undermine the basic principle under which Hino was designed to operate? Appellants respectfully submit that the answer is “no”.

For at least the foregoing reasons, the pending 35 U.S.C. § 103(a) rejection of claims 1, 2 and 4 as obvious over Hino and Brustle is improper. Accordingly, Appellants respectfully request this Honorable Board to reverse the Examiner at least upon these grounds.

2. Claim 3

The Examiner’s Answer presents a new ground of rejection: claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino and Brustle in view of Jones. *See id.*, § 9, at 6. Submission of this Reply Brief pursuant to 37 C.F.R. § 41.41 evinces Appellants wish to maintain the appeal. Appellants submit that claim 3 is patentably distinguishable from the prior art of record for at least those reasons as independent claim 1, from which it ultimately depends. *See supra*, § III.C.1, at 17-24. That is, the proposed incorporation of Jones into the combination of Hino and Brustle does not ameliorate the fact that the Examiner’s Hino and Brustle combination is factually and legally erroneous. For at least the foregoing reasons, the pending 35 U.S.C. § 103(a) rejection of claim 3 as obvious over Hino, Brustle and Jones is improper and should therefore be reversed.

3. Claims 5, 7-9, 27, 33 and 34

Claims 5, 7-9, 27, 33 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Lense. Independent claims 5 and 27 are rejected on the premise that Hino discloses every element and limitation respectively presented in claims 5 and 27, except for: “a track along which each moveable platform slides,” each of the moveable platforms “[being] at least substantially centered directly over a corresponding track” (claim 5); and “a plurality of individually moveable platforms,” each of which is “connected to a respective one of [a] plurality of tracks” and is “physically constrained to slide only ... along a corresponding one of said plurality of tracks,” (claim 27). *See Examiner’s Answer*, § 9, at 7-8. In light of these deficiencies, the Examiner attempts applies Lense, alleging that Lense shows a “a track (see Fig. 3, 26; Note: the overall track profile is a rectangle) for the purpose of

supporting a platform to slide in a coin receptacle station in the housing (column 1, lines 5-7).” *Id.*, at 8. It would therefore have been obvious, posits the Examiner, to modify Hino to include Lense’s track for the purpose of supporting a platform to slide in a coin receptacle station in the housing. *See id.* The pending § 103(a) rejection of claims 5, 7-9, 27, 33 and 34 is improper for at least three reasons: first, the Lense reference is non-analogous art; second, the Examiner has failed to provide an “apparent reason” to make the proposed modification of Hino in view of Lense; and third, the Examiner’s proposed combination of Hino and Lense is improper because it requires a substantial reconstruction and redesign of Hino.

a. The Lense reference is non-analogous art that may not be relied upon in rejecting the pending claims under § 103(a).

Similar to the Brustle reference, Lense is non-analogous art and therefore cannot be relied upon in rejecting the subject claims under § 103(a). First, Lense is in a different art from that of Appellants’ endeavor, and is therefore not analogous art. For instance, Appellants’ invention relates generally to coin processing devices, and more particularly to coin redemption machines with coin receptacles. *See* Specification, ¶ [0001]; Abstract. Lense’s invention, on the other hand, relates to a drawer slide assembly for supporting a drawer in the frame of a cabinet. *See* Lense, Col. 1, Ln. 5-7; Abstract. In addition, Appellants’ invention is classified in class 194 (check-actuated control mechanisms), subclass 350 (with specific housing structure), whereas Lense’s invention is classified in class 312 (cabinet structures), subclasses 334, 341 and 349 (having guide assembly with external guides or trackways). Likewise, Appellants’ and Lense’s inventions were categorized under different international classifications (G07F 1/04 and A47B 88/10, respectively). The different U.S. and international classifications designated by the USPTO for Lense and the subject application demonstrates that Lense is non-analogous art. *See* MPEP 2141.01(a). Respectfully, such non-analogous art may not be relied upon in attempting to substantiate a 103(a) rejection of Appellants’ claims.

In addition to **not** being in the same field of endeavor, Lense is also not “reasonably pertinent” because the matter with which it deals, logically, would not have reasonably commended itself to an inventor’s attention in considering the present invention as a whole. Independent claims 5 and 27 are directed to coin processing machines/devices with a

housing, a coin processing/sorting unit, and a coin receptacle station with a plurality of individually moveable platforms, each of which has at least one coin receptacle disposed thereon. The coin processing machine of claim 5 also includes a track along which each moveable platform slides when moving between the first and second positions, wherein each moveable platform is substantially centered directly over a corresponding track. The coin processing machine of claim 27 requires that each individually moveable platform be connected to a respective one of a plurality of tracks, and be physically constrained to slide only between the first and second positions along a corresponding one of the tracks.

In attempting to design a coin processing device with individually movable platforms that can simplify and alleviate the burden associated with accessing and removing voluminous amounts of coins of unwieldy bulk and weight (e.g., hundreds of pounds), such as that presented in claims 5 and 27, a person of ordinary skill in the art would not reasonably look to the design of a furniture drawer, such as that presented by Lense. For example, Lense's stated objective of "provid[ing] a novel construction and arrangement of the rollers and the associated track sections so that each roller has a relatively short axial profile but, at the same time, the roller has an effective diameter substantially greater than its actual diameter," Lense, Col. 1, Ln. 23-29, does not address any of the "problem(s)" addressed by Appellants' invention.

The additional remarks set forth in the Response to Arguments section of the Examiner's Answer do not present any factual foundation or substantive evidence to support the contention that Lense is reasonably pertinent to the particular problem with which the Appellants are involved. Rather, as highlighted above, the determination of analogousness is based on the Examiner's conclusion that Lense must be analogous because Lense and Appellants both include "moving parts." See Examiner's Answer, § 10, at 23, 24. Contrary to the Examiner's assertion, the mere fact that both Appellants and Lense employ "moving parts" in our respective inventions does not by itself establish that Brustle is analogous art. See *Estate of Stoller v. Ford Motor Co.*, 784 F.Supp. 506 (N.D.Ill. 1992). To conclude otherwise would defeat the sole premise of the doctrine of analogous art – i.e., any mechanical device with a moving part would be deemed analogous to Appellants' invention. The fact that Lense's invention and Appellants' invention both have moving parts does not substantiate that a person of ordinary skill would have consulted Brustle in seeking a solution to the problem that Appellants were attempting to solve.

For at least the foregoing reasons, Appellants submit that the pending § 103(a) rejection of claims 5, 7-9, 27, 33 and 34 is erroneous, and therefore respectfully request this Honorable Board to reverse the Examiner.

b. The record is absent any “apparent reason” why a person of ordinary skill in the art would be compelled to combine Hino and Lense to achieve Appellants’ invention.

The § 103(a) rejection of claims 5, 7-9, 27, 33 and 34 is also improper because the Examiner has not provided a motivation or apparent reason why a person of ordinary skill would be inspired to modify Hino in light of the teachings of Lense. As noted in Appellants’ Appeal Brief, § VII.D.3.b, the only perceived reason provided by the Examiner to modify Hino in view of Lense is “for the purpose of supporting a platform to slide in a coin receptacle station in the housing”. See Examiner’s Answer, § 9, at 8; Final Office Action, at 6, ¶ 3. Similar to the § 103(a) rejection of claim 1 based, in part, on Brustle, this purported motivation to combine Hino with Lense is merely a pretense to combine the elements from Hino with those of Lense. That is, one would be motivated to combine Hino (Coin Sorter) and Lense (Drawer Slide Assembly), alleges the Examiner, in order to achieve a combination of Hino and Lense (a coin sorter with a drawer slide assembly). The Examiner’s failure to articulate an actual reason why a person of ordinary skill in the art would be compelled to combine the cited prior art to achieve the invention “in the fashion claimed” is grounds alone to render the entire 103(a) rejection improper.

In addition, Hino’s storage unit 120 does not require the support of Lense’s drawer slide assembly 10. Hino’s wheeled storage unit 120 is already sufficiently supported by casters 122b that permit the storage unit 120 to be drawn out of and pushed into the coin processing unit 110. As such, Hino’s wheeled storage unit 120 does not require additional structure for “supporting a platform to slide in a coin receptacle station in [a] housing,” as proposed by the Examiner. Moreover, there is no evidence in Lense or anywhere on the record that Hino’s casters 122b “is simply substituted for another known mechanism [Lense’s drawer slide assembly 10],” as proposed by the Examiner. See Examiner’s Answer, at 24. In fact, Lense’s drawer slide assembly 10 is not robust enough to provide the requisite support for

Hino's storage unit 120 and, as explained below, would undermine the functional purpose of the storage unit 120.

Also similar to the § 103(a) rejection of claim 1, it was not until the Answer that the Examiner alleges, for the first time, that “simply substituting the disclosed track of Lense for the wheels of Hino **obtains predictable results** in that the moveable platform moves in a straight line.” Examiner’s Answer, § 10, at 24 (emphasis added). As to this new assertion of “predictable results,” Appellants respectfully submit that this mere assertion is improper basis upon which to premise a conclusion of obviousness and evinces an improper reliance on *ex post* reasoning. “Knowledge after the event is always easy, and problems once solved present no difficulties.” *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U.S. 428, 435 (1911). The esteemed Judge Learned Hand likewise identified the problem of hindsight bias making inventions appear obvious after-the-fact because all inventions, at their core, are combinations of prior art, but he emphasized that such an after-the-fact perspective does not prevent an invention from being original. *B. G. Corp. v. Walter Kiddie & Co.*, 79 F.2d 20, 22 (2d Cir. 1935)(Hand, J.). *Graham v. John Deere Co. of Kansas City* warned against a “temptation to read into the prior art the teachings of the invention in issue” and instructed courts to “‘guard against slipping into the use of hindsight’” 383 U.S. 1, 36 (1966)(quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412, 141 USPQ 549 (CA6 1964))). More recently, the Supreme Court in *KSR Int’l Co. v. Teleflex Inc.* cautioned that the factfinder “should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1397 (2007). *KSR* does not sanction hindsight combination of elements taken from the prior art. Although, as noted in MPEP § 2141 and *KSR*, “in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle,” however such statement, in context, relates particularly to the Court’s inquiry into the “market pressure” to solve the known problem at issue in that case and the “finite number of identified, predictable solutions” that were available to a person of ordinary skill, thereby providing a “good reason to pursue the known options within his or her technical grasp.” 127 S.Ct. at 1742. The Examiner’s proffered “apparent reason” in the instant case is submitted not to comport with the above-noted case law and is therefore insufficient to substantiate a *prima facie* case of obviousness against claims 5 and 27. The Examiner has failed to discharge his burden to expressly articulate, *inter alia*, a

finding that each element merely performs the same function as it does separately; and a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable (*see, e.g.*, MPEP 2143(A)). The record does not reflect either of these findings; consequently, the record is still missing the fully articulated apparent reason required by the Supreme Court in *KSR*. A *prima facie* case of obviousness is thus still lacking.

For at least the foregoing reasons, Appellants submit that the pending 103(a) rejection of claims 5, 7-9, 27, 33 and 34 is erroneous, and therefore respectfully request this Honorable Board to reverse the Examiner.

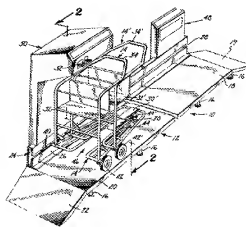
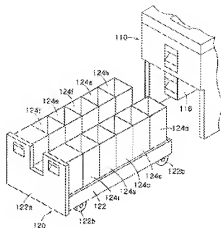
c. The Examiner's proposed combination of Hino and Lense is improper because it requires a substantial reconstruction and redesign of Hino.

In addition to Lense being non-analogous art and the lack of a proper motivation or reason to combine Hino and Lense, any such combination would require a substantial "reconstruction and redesign" of the elements shown in Hino, as well as a change in the basic principle under which Hino's storage unit 120 was designed to operate. The discussion above with respect to the proposed modification of Hino in light of Brustle, *supra* § III.C.1.c, at 22-24, is equally relevant here, and therefore is incorporated by reference but is otherwise omitted for brevity. In particular, if one were to assimilate Lense's drawer slide assembly, shown in reference FIG. 9 (recreated below), including, *inter alia*, mechanically attaching the upper and lower elongated members 25, 26 to Hino's housing 110 or storage unit 120, would require redesigning Hino's storage unit 120 to be continuously attached and fixed to the coin processing unit 110. If one were to modify Hino to include Lense's drawer slide assembly, as proposed by the Examiner, an operator of Hino's coin processing device 110 would no longer be able to move the storage unit 120 away from the device 110, as is clearly intended by the design depicted in FIG. 4 of Hino. Like the office actions before it, the Answer does not even address this problem. As such, there would be no motivation to modify Hino in light of Lense because it would change the basic principle under which Hino's storage unit 120 was designed to operate. *See In re Ratti*, 270 F.2d at 813.

obviousness. First, Muellner is in a different art from that of Appellants' endeavor, and is therefore not analogous art. Appellants' invention relates generally to coin processing devices, and more particularly to coin redemption machines with coin receptacles, *see* Specification, ¶ [0001], Abstract, whereas Muellner's invention relates to carts for transporting baggage, packages and groceries, *see* Muellner, Col. 1, Ln. 5-15, Abstract. In addition, the different U.S. classifications (Appellants: G07F 1/04; Muellner: 211/17) and international classifications (Appellants: 194/350; Muellner: A47F 7/00) assigned by the USPTO for Muellner and the subject application demonstrates that Muellner is non-analogous.

In addition to **not** being in the same field of endeavor, Muellner is also not "reasonably pertinent" because the matter with which it deals, logically, would not have reasonably commended itself to an inventor's attention in considering the present invention as a whole. Independent claim 25 presents "[a] method for processing coins with a coin processing machine". The coin processing machine of claim 25 includes a housing, a coin sorting unit disposed within the housing, and a plurality of moveable coin receptacle platforms each bearing at least one coin receptacle. Each coin receptacle platform is disposed over a track, and is independently moveable on the track.

In designing a method for processing coins with a coin processing machine, as that presented in claim 25, a person of ordinary skill in the art would not reasonably look to the design of a luggage cart, such as that presented by in FIG. 1 of Muellner (recreated below). For example, Muellner's stated objective of "preventing insertion of ... a cart, into a capturing apparatus, such as a dispensing island, in a direction other than a desired nesting direction," Muellner, Col. 2, Ln. 34-38, does not address any of the problem(s) addressed by Appellants' invention.



The additional remarks set forth in the Response to Arguments section of the Examiner's Answer do not present any factual foundation or substantive evidence to support the contention that Muellner is reasonably pertinent to the particular problem with which the Appellants are involved. Rather, as highlighted above, the determination of analogousness is based on the Examiner's conclusion that Muellner must be analogous because Muellner and Appellants both employ "moving parts." See Examiner's Answer, § 10, at 23. However, the mere fact that both Muellner and Appellants employ "moving parts" does not by itself establish that Muellner is analogous art. See *Estate of Stoller v. Ford Motor Co.*, 784 F.Supp. 506 (N.D.Ill. 1992). To conclude otherwise would defeat the sole premise of the doctrine of analogous art – i.e., any mechanical device with a moving part would be deemed analogous to any other device with a moving part and, as the corollary, that any device with a stationary part would be deemed analogous to any other device with a stationary part.

For at least the foregoing reasons, Appellants submit that the pending § 103(a) rejection of claim 25 is erroneous, and therefore respectfully request this Honorable Board to reverse the Examiner.

b. The Hino, Muellner and Lense references do not teach each and every limitation of base claim 25.

Hino, Lense and Muellner, whether considered singly or in aggregate, have not been shown to teach each and every limitation of claim 25. On page 25 of the Answer, the Examiner appears to agree with Appellants that neither Lense nor Muellner is directed toward a

coin processing device, and therefore cannot disclose “determining, using a controller, if a predetermined number of coins have been discharged to one of the coin receptacles,” or “automatically terminating coin sorting when said controller determines that a predetermined number of coins have been discharged to said one coin receptacle,” as set forth in claim 25. Hino is therefore the sole point of disagreement on this issue.

Hino does not depict, describe or otherwise disclose the act of “**determining**” if a “**predetermined** number of coins” have been discharged into one of the coin receptacles and, in response to the controller **determining** that a predetermined number of coins have been discharged into that receptacle, the system “**automatically terminat[es]** coin sorting”. (Emphasis added.) The Examiner claims that Appellants’ claimed act of “determining” is disclosed in paragraph [0042] of Hino, *see* Examiner’s Answer, at 10; however, this section of Hino is directed solely to the manner by which Hino’s coin sorting apparatus sorts coins of different diameters, and does not support the Examiner’s allegations that Hino teaches the limitations highlighted above. In the Response to Arguments section of the Answer, the Examiner attempts to clarify this allegation and bolster his position by stating that:

coins of different diameters are fed into the coin sorter of Hino (paragraph [0042]). In paragraph [0037], as in most coin sorters, **all the nonrejected (determined by a controller) coins are counted. The predetermined number of coins is all the coins.** Once the sorting and counting of all the coins is finished, the coin sorting is automatically terminated.

Id., at 25 (emphasis added). Heretofore, the Examiner has not made a *prima facie* case of obviousness against claim 25 because the applied references have not been shown to teach each and every limitation contained therein.

First and foremost, claim 25 positively recites the act of “determining” via a controller “if a predetermined number of coins have been discharged”. The Examiner alleges that the “predetermined” number of coins is all the coins fed into Hino’s coin sorter. Appellants wonder how the number of coins fed into the coin sorter could be “predetermined” before they are even processed by Hino’s apparatus? Even if the number of coins in the batch of coins were known by the operator prior to being fed into Hino’s coin processing unit 100 (which there is no evidence in Hino or otherwise substantiating such an allegation), that does not disclose, teach or suggest actively “determining, *using a controller*, if a predetermined number of coins have been

discharged” (emphasis added) into a coin receptacle, as required by claim 25. Contrary to the allegations highlighted above, **paragraph [0037] of Hino does not teach counting rejected coins**, via a controller or otherwise. Even if Hino does teach counting coins, which the Examiner has not yet shown, that is not disclosure of comparatively determining if the coins discharged into a particular receptacle has reached a predetermined threshold. Based on this omission alone, the § 103(a) rejection of claim 25 is improper and should therefore be reversed.

In addition to the above omission, paragraphs [0037] and [0042] of Hino fail to disclose “automatically terminating” coin sorting when the controller determines that the predetermined number of coins have been discharged into the coin receptacle. Even if Hino’s coin sorting apparatus has finished counting every coin input by a user, the Examiner has not provided any factual evidence that Hino’s apparatus is configured to automatically terminate coin sorting once all of the coins have been processed. Based on the same unsubstantiated speculation being applied by the Examiner, it is just as likely to conclude that Hino’s coin sorter 110 will continue to run even after the input batch of coins has been processed (e.g., until manually shut off). The pending rejection of claim 25 violates Federal judicial precedent as the applied references do not suggest or disclose all the limitations in the claim. *See In re Royka*, 490 F.2d 981 (CCPA 1974).

For at least the foregoing reasons, Appellants submit that the pending 103(a) rejection of claim 25 is erroneous and should therefore be reversed.

c. The record is absent an “apparent reason” why a person of ordinary skill in the art would be compelled to combine Hino and Lense or Hino and Muellner to achieve Appellants’ claimed invention.

In addition to Lense and Muellner being non-analogous art and Hino, Lense and Muellner failing to disclose each and every limitation of claim 25, the Examiner has not provided a proper motivation or an “apparent reason” why a person of ordinary skill would be inspired to modify Hino (coin machine coin receptacle) in light of the teachings of Lense (furniture drawer) or Muellner (nesting shopping carts). With regard to the former, the discussion above with respect to the proposed combination of Hino and Lense as it pertains to base claims 5 and 27, is equally relevant here, and is therefore incorporated by reference herein it is entirety but is

otherwise omitted for brevity. *See supra* § III.C.3.b, at 27-29. With regard to Muellner, the Examiner proposes that “it would have been obvious ... to modify Hino ... [to] include Muellner’s similar device having a track for the purpose of receiving and capturing the casters.” Curiously, this asserted motivation “[to] include Muellner’s similar device having a track for the purpose of receiving and capturing the casters” is incongruent with the Examiner’s asserted motivation for combining Lense, which is purported to have been obvious to combine the track thereof “for the purpose of supporting a platform to slide in the housing”. Stated differently, if as asserted by the Examiner one of ordinary skill in the art would have employed the Lense track in place of the casters to support the platform 120 of Hino, then why would of ordinary skill in the art then additionally look to Muellner’s shopping cart rack for a device to capture casters? “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be ‘some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’” *KSR*, 127 S. Ct. at 1741 (*citing In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). The Examiner’s failure to articulate an actual reason, with rational underpinning, as to why a person of ordinary skill in the art would be compelled to combine the cited prior art to achieve the invention “in the fashion claimed” is itself respectfully submitted to render the § 103(a) rejection improper and reversal is respectfully requested.

d. The Examiner’s proposed combination of Hino and Lense or Hino and Muellner is improper because it requires a substantial reconstruction and redesign of Hino.

The discussion above with respect to the proposed combination of Hino and Lense as it pertains to base claims 5 and 27, is equally relevant here, and is therefore incorporated by reference. *See supra* § III.C.3.c, at 29-30. In a similar respect, modifying Hino in light of Muellner, as proposed by the Examiner, would require a “reconstruction and redesign” of Hino’s storage unit 120. That is, the storage unit 120 would have to be redesigned to be received in and mate with Muellner’s nestable cart anti-reversing apparatus. The Examiner’s proposed modification changes the basic principle under which Hino’s storage unit 120 was designed to operate. Hino’s storage unit 120 was specifically designed such that the wheeled drawer 122 can be inserted into and retracted from the front of the housing of the coin processing

unit 110. *See*, Hino FIGS. 2-4, ¶¶ [0135]-[0136]. If one were to incorporate the teachings of Muellner into the apparatus featured by Hino, as proposed by the Examiner, an operator would be completely prevented from retracting the cart 120 (as shown in reference FIG. 4 of Hino) after inserting it into the coin processing device 110 housing. *See* Col. 2, Ln. 34-56; Col. 4, Ln. 36-64; Col. 5, Ln. 1-16. As such, there would be no cognizable motivation to make the Examiner's proposed modification of Hino in light of Lense.

The Examiner responds to these assertions in the Response to Arguments section of the Answer by opining, *in toto*, that "the claims are not limited to the casters/wheels not being captured temporarily in the second position, i.e., the claims do not exclude the possibility of the casters/wheels being captured temporarily in the second position." Examiner's Answer, § 10, at 25. The Examiner appears to misunderstand Appellants argument. The deficiencies identified in this section of the Reply Brief, and discussed in § VII.D.4.c of Appellants Appeal Brief, are directed to the erroneous nature of the Examiner's proposed modification of Hino with Lense, not the content of claim 25. Appellants have indicated on numerous occasions that **an examiner's proposed modification** of a cited reference is not sufficient to render a claim *prima facie* obvious if the proposed modification/combination changes the principle of operation of the prior art invention being modified, undermining the basic principles under which the prior art was designed to operate. *See* MPEP 2143.01(VI). The fact that claim 25 may or may not exclude the possibility of the casters/wheels being temporarily captured in the second position, as proposed by the Examiner, is irrelevant to the fact that the Examiner's proposed modification of Hino with Muellner changes the principle of operation of the Hino reference, contrary to established precedent (*see, e.g., In re Ratti*, 270 F.2d 810 (CCPA 1959)(If a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious.)).

For at least the foregoing reasons, the pending 35 U.S.C. § 103(a) rejections of base claim 25 as obvious over Hino and Lense or Hino and Muellner are improper. As such, Appellants respectfully request this Honorable Board to reverse the Examiner.

5. Claims 27 and 33

Claims 27 and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Muellner. The pending § 103(a) rejection of claims 27 and 33 is believed to be improper for at least four reasons: first, the Muellner reference is non-analogous art; second, Hino and Muellner do not teach each and every limitation of base claim 27; third, the Examiner has failed to provide an “apparent reason” to make the proposed modification of Hino in view of Muellner; and fourth, the Examiner’s proposed combination of Hino and Muellner is improper because it requires a substantial reconstruction and redesign of Hino.

a. The Muellner reference is non-analogous art and therefore may not be relied upon in rejecting claims 27 and 33 under § 103(a).

Muellner is non-analogous art to the § 103(a) rejection of independent claim 27 for the same reasons it is non-analogous art in the § 103(a) rejection of base claim 25. *See supra*, § III.C.4.a, at 30-32.

b. The Hino and Muellner references do not teach each and every limitation of independent claim 27.

The combination of Hino and Muellner does not teach, suggest, or otherwise disclose each and every limitation of claim 27. For instance, neither Hino nor Muellner discloses, *inter alia*, “a plurality of individually moveable platforms each having at least one coin receptacle disposed thereon”. In addition, Hino and Muellner, individually and collectively, fail to disclose a “**a plurality of tracks**” or, for that matter, even a single track whereat each of the individually moveable platforms is “connected to a respective one of the plurality of tracks and [is] **physically constrained** to slide only from said first operable position to said second inoperable position and [back] ... **along a corresponding one of said plurality of tracks**”. (Emphasis added.)

The Examiner again argues, in reliance upon MPEP § 2144.04(VI)(B) and *In re Harza*, 274 F.2d 669 (CCPA 1960), that Appellants’ claimed “plurality of individually moveable platforms” is “a mere duplication” of the single, moveable cart 120 disclosed in Hino, and

therefore, would have been obvious to one of ordinary skill in the art. Although the holding in *Harza* is not a *per se* rule, the Examiner impermissibly treats it as such. *See In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995). For a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. *See In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976). The possibility that the prior art “could be” modified is not sufficient to establish *prima facie* obviousness. *See In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). To date, the Examiner has not set forth any evidentiary basis upon which this conclusion may be legitimately founded.

Utilization of multiple, individually-movable platforms in the manner disclosed by Appellants does function differently than a single, movable drawer, such as is provided in Hino. By way of example, the claimed “plurality of individually moveable platforms” serves to facilitate access to the coin receptacles contained within a coin processing machine and, depending on which coin receptacle(s) the operator needs to empty, the operator is enabled to slide out one of the moveable platforms at a time (*see, e.g.*, FIG. 6) to access coins contained in the coin receptacle(s) of interest (*see, e.g.*, ¶ [0051]). In clear contradistinction, for the same operator to access many of Hino’s coin sorting cassettes 124a-124i (*e.g.*, ones at the rear of the wheeled cart 122) requires the entire cart 120 be removed from the coin sorting device 100. By Federal Judicial precedent, the Examiner therefore was required, and has still failed to, explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the asserted modification.

In addition to the deficiencies highlighted above, Hino and Muellner also fail to disclose platforms that “slide” between “said first operable position to said second inoperable position”. The Examiner cites FIG. 4 of Hino, alleging that “122 slides into the compartment of 110”. Such a construction is not “reasonable”. The “broadest reasonable interpretation” of the claims permitted by law must be consistent with “the interpretation that those skilled in the art would reach.” *In re Cortright*, 165 F.3d 1353, 1359 (Fed. Cir. 1999). In this vein, “[c]laims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their ‘broadest reasonable interpretation’.” *In re Marosi*, 710 F.2d 799, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). Claims must be read in view of the specification, of which they are a part.

The Examiner improperly interprets the term “slide” to include a generalized movement of drawer 122 supported by casters 122b. The Examiner opines, without any supporting evidence, that “sliding refers to the translational motion of a body,” and “[s]ince the coin storage unit 120 translates as a whole, it slides.” Examiner’s Answer, § 10, at 25. The Examiner thus completely disregards the context of the recited terminology as it would be reasonably interpreted by one of ordinary skill in the art. Based on the Examiner’s same logic, an flying airplane would thus be sliding so long as it “translates as a whole”; a long distance sprinter is sliding so long as he/she “translates as a whole”. This construction is completely unreasonable, as it would classify and translational movement as sliding. To wit, Hino’s coin storage unit 120 does not “slide” into the compartment 110. When it is pushed, the casters roll, and the coin storage unit 120 rolls into the compartment.

For at least the foregoing reasons, the pending 35 U.S.C. § 103(a) rejection of claims 27 and 33 as obvious over Hino and Mueller are improper. As such, Appellants respectfully request this Honorable Board to reverse the Examiner.

c. The record is absent an “apparent reason” why a person of ordinary skill in the art would be compelled to combine Hino and Mueller to achieve Appellants’ claimed invention.

In addition to Mueller being non-analogous art, and Hino and Mueller failing to disclose each and every limitation of claim 27 the Examiner has not provided a proper motivation or an “apparent reason” why a person of ordinary skill would be inspired to modify Hino in light of the teachings of Mueller. See, e.g., § III.C.4.c at 34-35. Remarkably, even after pointing out this deficiency in the Appellants’ Appeal Brief, the Examiner did not address this deficiency in the Answer.

d. The Examiner’s proposed combination of Hino and Mueller is improper because it requires a substantial reconstruction and redesign of Hino.

The discussion above with respect to the proposed combination of Hino and Mueller as it pertains to base claim 25 is equally relevant here, and is therefore incorporated by

reference. *See supra* § III.C.4.d, at 35-36. Remarkably, even after pointing out this deficiency in the Appellants' Appeal Brief, the Examiner did not address this deficiency in the Answer.

6. Claims 10, 12-16, 26, 30 and 31

Claims 14-16 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Lense, and further in view of Siemens. Claims 14-16 and 26 are also rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Muellner, and further in view of Siemens. In addition, claims 10, 12-13 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Lense, and further in view of Jones. Claim 30 is also rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Muellner, and further in view of Jones. Finally, claim 31 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Lense, and further in view of Jones.

Claim 10 depends from independent claim 5 through intermediary dependent claims 7 and 8. Claim 12 depends from claim 10. Claim 13 depends directly from independent claim 5. Claim 14 depends directly from independent claim 5. Claims 15 and 16 each depend from dependent claim 14. Claim 26 depends directly from independent claim 25. Claim 30 depends directly from independent claim 27. Claim 31 depends from dependent claim 27. Similar to the discussion set forth hereinabove, Appellants respectfully submit that claims 10, 12-16, 26, 30 and 31 are each patentably distinguishable from the prior art of record for at least those reasons as the independent claims from which they respectively depend.

Appellants respectfully submit that the variety of modifications and combinations proposed by the Examiner do not cure the fact that the prior art of record fails to render obvious any of the pending independent claims and that the pending § 103(a) rejections of claims 10, 12-16, 26, 30 and 31, noted above, are factually and legally erroneous. Reversal of the Examiner is respectfully requested as to each of these rejections.

VII. SUMMARY

For the foregoing reasons, Appellants respectfully solicit this Honorable Board to reverse the Examiner's 35 U.S.C. § 112, first paragraph, rejections of claims 26 and 27, 35 U.S.C. § 112, second paragraph, rejections of claims 26 and 27, and 35 U.S.C. § 103(a) rejections of claims 1-5, 7-16, 25-27, 30, 31, 33 and 34, at least upon the grounds noted above.

* * * * *

The Commissioner is hereby authorized to charge Nixon Peabody, P.C. Deposit Account No. 50-4181, Order No. 247171-000390USPT, for any fees that may be inadvertently omitted which may be necessary now or during the pendency of this application, except for payment of the issue fee.

Respectfully submitted,

Date: April 7, 2010

By: /William D. PEGG, Reg. # 42,988/
William D. Pegg
Reg. No. 42,988
Nixon Peabody LLP
300 South Riverside Plaza
16th Floor
Chicago, Illinois 60606
(312) 425-3900
Attorney for Appellants